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10/591,930	09/07/2006	Michael Vernon Spencer	63669A	4599

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EXAMINER	
NIEBAUER, RONALD T	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL VERNON SPENCER

Appeal 2010-004978
Application 10/591,930
Technology Center 1600

Before RICHARD E. SCHAFER, MICHAEL P. TIERNEY, and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This a request for a rehearing pursuant to 37 C.F.R. § 41.52 (hereinafter, "Req. Reh'g," dated January 7, 2011) of the Decision to affirm the Patent Examiner's rejections of claims 1-5, 7, 8, and 17-19 in U.S. Application 10/591,930 (notification date of November 10, 2010; hereinafter "Dec.").

The appealed claims are directed to a process comprising depolymerizing an ethylcellulose in the presence of a gaseous hydrogen halide to achieve a reduction in the viscosity of the ethylcellulose, and then packaging the depolymerized product without a neutralization step. The

Examiner rejected the claims (1) under 35 U.S.C. § 103 as obvious in view of cited prior art publications, and (2) under non-statutory obviousness-type double patenting.

The Examiner found that the claimed depolymerization process was taught by the combination of cited prior art publications, but found that the publications not disclose packaging the depolymerized ethylcellulose "without neutralization" as recited in the claims. However, the Examiner determined, based on the cited prior art, that it would have been obvious to have omitted the neutralization step. In the Decision, we concluded that the Examiner's determination was supported by a preponderance of the evidence and affirmed the rejections.

Appellant, in this rehearing, contends we erred in finding that the cited prior art taught that neutralization was an optional step which could be omitted (Req. Reh'g 1). Appellant also contends that we erred by relying on Claim 1 of the cited Schulz publication to support our decision that the claimed subject matter would have been obvious to the ordinary skilled worker (*id.*).

As stated in the Decision, "Schulz and Keary describe partially neutralizing the acid, indicating that it is unnecessary to completely remove the acid from the packaged polymer and that neutralization is not a critical step of the process (Answer 21; FFs[1] 2, 3, & 4)." (Dec. 7). When acid is removed only "partially" (FF2), logically some acid would remain in the depolymerized packaged polymer. Thus, the prior art (FF1, FF2, & FF4) includes embodiments with excess remaining acid – reasonably suggesting that a neutralization step to "neutralize" remaining acid is not absolutely

[1] "FF" refers back to the Findings of Fact in the "Dec."

needed. In other words, omitting a neutralization step from the cited prior art process would be akin to carrying out a *partial* neutralization step because both steps would result in the presence of acid in the depolymerized product – a result that is apparently tolerated by Schulz.

Schulz stated: "Following depolymerization, the particulate cellulose ether is contacted with a basic compound, preferably a substantially anhydrous basic compound, to partially or substantially neutralize *any remaining acid*." (Col. 5, ll. 17-20; FF2; emphasis added.) We cited the italicized passage as further supporting the conclusion that, if there were no acid present, a neutralization step would not be necessary (Dec. 7). Appellant contends that "those skilled in the art can be presumed to know acid will always be present," arguing that we misconstrued "any remaining" to refer back to whether acid is present or absent (Req. Reh'g 1).

The proper construction of the phrase "any remaining acid" in the context of the above-quoted sentence (FF2) does not change the teaching in the same sentence that the acid can be "partially or substantially neutralize[d]." As the latter fact was adequate evidence to affirm the Examiner's rejection, we do not find it necessary to engage in further interpretation of the sentence and deem the issue moot.

Appellant also contends that we erred by relying on Claim 1 of the cited Schulz publication to support our decision (Req. Reh'g 1).

We did not rely on Claim 1 of the Schulz publication in reaching our Decision. We expressly wrote: "The Examiner buttressed this finding [about whether a neutralization step could be omitted] by pointing to claim 1 of the Schulz patent which is drawn to a depolymerization process which omits the acid neutralization step (FF 3)." (Dec. 7). Thus, it was clear that

we were merely stating the Examiner's position, not our own. To summarize, the disclosure in Claim 1 of the Schulz patent was not relied upon or needed in the Decision to conclude that the claimed subject matter was obvious over the cited prior art references.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING DENIED

ack

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